

Application No. 09/851,210

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**REMARKS**

This Preliminary Amendment accompanies a Request for Continued Examination, and is a response to the Final Office Action of September 22, 2006. Applicants have carefully considered the rejections of the Examiner in the above-identified application. In light of this consideration, Applicants believe that the claims as amended are allowable. Applicants respectfully request reconsideration of the rejection of the claims now pending in the application.

In the first Office Action of December 1, 2004, claims 1 and 8 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 1-3 and 5-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,390,035, to Kasson et al. (hereinafter Kasson) in view of U.S. Patent No. 5,982,990, to Gondek (hereinafter Gondek). Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kasson in view of Gondek and U.S. Patent No. 5,553,199, to Spaulding, et al. (hereinafter Spaulding).

An Appeal was taken with an Appeal Brief filed December 29, 2005. Subsequently prosecution was re-opened March 31, 2006.

In the second Office Action of March 31, 2006, claims 1-16 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Claims 1-7 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-5 and 7-15 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Application Publication No. 2001/0028471, to Hirokazu (hereinafter Hirokazu). Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of U.S. Patent No. 5,185,661, to Ng (hereinafter Ng). Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Kasson.

In this Office Action of September 22, 2006, claims 1-16 are rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Claims 3 and

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9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-5 and 7-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Gondek. Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Gondek and Ng. Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Gondek and Kasson.

Claims 1-16 are rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. The claims have been amended as per the suggestions of the Examiner and are thus believed to overcome that rejection. The Applicants wish to express their appreciation for the Examiner's suggestions. The Applicants respectfully request withdrawal of the 35 U.S.C. §101 rejection of claims 1-16.

Claims 3 and 9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. It is believed that claims 3 and 9 as currently amended overcome this rejection and allowance of claims 3 and 9 is respectfully requested. Claim 15 has also been amended in observance of this inadvertent mistake of antecedent basis.

Claims 1-5 and 7-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Gondek. Hirokazu is directed to providing proof print sheets representative of a rotary press and the like. Hirokazu does not tessellate color space into *regions* defined by *using the vertices representing each* available ink. In other words, Hirokazu does not contemplate or teach dividing up the *entire available color gamut* available for a given set of ink colorants. It is well understood by those skilled in the art that no color print system can produce colors outside the color gamut defined by the available ink colorants. Hirokazu provides sample discreet spot colors as printed upon a proof page, and as such provides points that may define very small continuous regions (as is used in *arguendo* by the Examiner on page 8 lines 5-17 of the office action), thus failing to divide up the entire available printer gamut because

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Hirokazu never contemplates or teaches to regard the entire available printer gamut. This is understandably so, as Hirokazu is directed to producing proof sheets for the sake of correcting color profiles where the direct observation of small colorant variations is contemplated and expected, but NOT the examination of the entire printer gamut.

The Applicant must remain firm in his conviction that one skilled in the art would never profess confusion as to what is a considered redundant color in the printing arts. Utilization of CMYK is ubiquitous in the art, and the K (the black) is never considered to be what is meant by redundant. It is considered present, as the Examiner points out in the office action, as a cost reducer, because black colorants are cheaper than CMY colorants. But more importantly, the Applicant goes to some trouble to state as to what is meant by redundant ink print systems on pages 4 and 5, of the Application Specification. For example the Application states that *"In a typical color system, all the needed colors are rendered using ... yellow, magenta, cyan and black (YMCK). In a redundant color system, there will be some larger set of colorants available."* The patent law allows the inventor to be his own lexicographer and the Applicant thereby requests that the redundant be defined as is found and understood in the printing arts.

Gondek while ostensibly directed to redundant color inks, never-the-less fails to provide for what Hirokazu lacks. Indeed Gondek states that the problem (which the Applicant addresses) is to be solved "empirically", (please see column 7, lines 40-57 of Gondek) and thus Gondek teaches away from the Applicant's teaching provided in the present Application Specification and claims.

It is therefore respectfully requested that the rejection of claims 1-5 and 7-15 as rejected under 35 U.S.C. §103(a) be withdrawn. Allowance of claims 1-5 and 7-15 is respectfully requested.

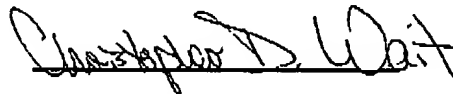
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Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Ng. Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Kasson. Since claims 6 & 16 depend from claims deemed allowable they should be allowable as well. Allowance of claims 6 & 16 is respectfully requested.

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby requested to call the undersigned attorney at (585) 423-6918, Rochester, NY.

Respectfully submitted,



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February 22, 2007  
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